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EXAMINER

DESAI, ANISH P

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. **Continuation of Box 3:**

2. The after-final amendment is not entered into consideration given that the amendment raises new issues that would require further consideration under 112-first paragraph in light of the amendment to claim 7 to change the upper limit of the weight average molecular weight from 20,000 to 14,000. Additionally, it appears that there is no support for “8,000 to 14,000”, since “14,000” is one end point that is provided in the example. Further, the amendment is not entered into consideration because the amendment to claim 1 to recite “and optionally one of more polymerizable compounds” , which raises new issues that would require further consideration and search given that the amendment broadens the scope of the claims. Specifically, while the presence of polymerizable compounds was previously required, now they are optional which broadens the scope of the claim.

3. **Continuation of Box 11:**

4. Regarding applicant’s response, it is respectfully submitted that the response is not found persuasive because it relies on an amendment that is not entered into consideration. Additionally, it is submitted that even if the amendment were entered the 112, first rejection of record would be maintained against claim 7 for the following reasons:

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5. The Examiner submits that there is no support to recite either 8,000 or 14,000 as values for the weight average molecular weight of the difunctional urethane (meth)acrylate. As set forth in MPEP 2163.05 III, with respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the present case, there is no disclosure in the present specification to indicate that applicants' had possession of weight average molecular weight of 8,000-14,000 for the broad disclosure of urethane (meth)acrylate as presently claimed. As support for these values, applicants point to the examples, however, while these provide support to recite weight average molecular weight of 8,000 or 14,000 for specific types of urethane (meth)acrylate, respectively, this does not provide support to recite weight average molecular weight of 8,000-14,000 for the broad disclosure of urethane (meth)acrylate as presently claimed.

6. The Examiner submits that if the amendment were entered, the 35 USC Section 112-first paragraph rejections against claim 9 as set forth in Section 8 of the previous Office action, and the 35 USC Section 112-second paragraph rejection of the record would be overcome.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794